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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,709	03/09/2000	Andres Torrubia-Saez	TRYM0001C	2514

22862 7590 02/02/2004

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EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 02/02/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/521,709

Applicant(s)

TORRUBIA-SAEZ, ANDRES

Examiner

Benjamin E Lanier

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see paper 7, filed 09 January 2004, with respect to the rejection(s) of claim(s) 1-51 in view of Molnar have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hurley, U.S. Patent No. 5,984,508.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-51 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 14-40 of copending Application No. 09/328,737. Although the conflicting claims are not identical, they are not patentably distinct from each other because by applicant's own admission the current application and '737 application claim a single software package having both a trial version and a purchase version.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-23, 25-28, 28-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurley, U.S. patent No. 5,984,508. Referring to claims 1-4, 7-11, 13-20, 22, 23, 25, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the software (Abstract). The lock would meet the limitations of an access control object for preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is

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provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access control code is provided by the vendor to the user upon purchase of the product, and serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3).

Referring to claim 5, Hurley discloses the storage device that the computer package can be stored on is a hard drive (Col. 1, lines 17-20).

Referring to claims 6, 26-28, Hurley discloses that the access control code (decryption key) unlocks products and features (decrypts) (Col. 5, lines 1-3).

Referring to claim 12, Hurley discloses that the software package can contain audio, video, and image data (Col. 1, lines 28-31).

Referring to claim 21, Hurley discloses that the software can be purchased via a credit card (Col. 1, lines 46-49).

Referring to claims 48-51, Hurley discloses that the access control code contains information to insure its validity (watermark) (Col. 4, lines 64-66).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurley, U.S. Patent No. 5,984,508, in view of Cooper, U.S. Patent No. 5,598,470. Referring to claim 24, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the software (Abstract). The lock would meet the limitations of an access control object for preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access control code is provided by the vendor to the user upon purchase of the product, and serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3). Hurley does not disclose that the system serial number is a hard disk or storage medium serial number. Cooper discloses the software distribution system wherein the system attributes of the user's computer system are used by encrypting the software package utilizing a key based on the computer system information (Col. 7, lines 1-5). Some of the system attributes may include hard

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disk serial number, format of hard disk, system model number, hardware interface cards, hardware serial number, and other configuration parameters (Col. 14, lines 28-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use system attributes of the storage medium on the user's computer system for the protection of the software package in order to ensure that only the user's computer system may access the software package as taught in Cooper (Col. 2, lines 10-24).

8. Claims 29-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurley, U.S. Patent No. 5,984,508, in view of Cooper, U.S. Patent No. 5,598,470. Referring to claims 29-36, 38, 39, 41, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the software (Abstract). The lock would meet the limitations of an access control object for preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access control code is provided by the vendor to the user upon purchase of the product, and

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serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3). Hurley does not disclose the key or validation code containing a signature. Cooper discloses the decryption key having a signature. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a signature in the validation code of Hurley in order for a user of the trial use computer program system of Hurley to verify that the key or validation code that they have purchased is valid and authentic.

Referring to claim 37, Hurley discloses that the software can be purchased via a credit card (Col. 1, lines 46-49).

Referring to claim 40, Cooper discloses the software distribution system wherein the system attributes of the user's computer system are used by encrypting the software package utilizing a key based on the computer system information (Col. 7, lines 1-5). Some of the system attributes may include hard disk serial number, format of hard disk, system model number, hardware interface cards, hardware serial number, and other configuration parameters (Col. 14, lines 28-34).

Referring to claims 42-44, Hurley discloses that the access control code (decryption key) unlocks products and features (decrypts) (Col. 5, lines 1-3).

9. Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurley, U.S. Patent No. 5,984,508, in view of Drake, U.S. Patent No. 6,006,328. Referring to claims 45-47, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the software (Abstract). The lock would meet the limitations of an access control object for

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preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access control code is provided by the vendor to the user upon purchase of the product, and serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3). Hurley does not disclose monitoring for class attacks and dump attacks. Drake discloses software security system wherein the operating system is monitored for certain modifications like pointer table modifications (Col. 6, lines 26-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to monitor the software distribution system of Hurley for such modifications in order to detect and prevent tampering as taught in Drake (Col. 6, lines 30-31).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

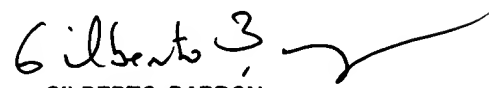
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Benjamin E. Lanier



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